PATENT
Attorney Docket Nº 02-5976

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	James Pate
Serial Nº	:	10/620,778
Filed	:	July 15, 2003
Group Art Unit	:	2876
Examiner	:	Nguyen, Kimberly D.
For	:	METHOD AND APPARATUS FOR AUTOMATICALLY TRACKING AND COMMUNICATING DATA STORAGE DEVICE INFORMATION USING RF TAGS: OPERATING CONDITION, CONFIGURATION AND LOCATION

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service on December 14, 2006, in a First Class envelope, with sufficient postage thereon, addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

ReNea D. Berggren

ReNea D. Berggren DATED: December 14, 2006

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This *Request* is being filed with a *Notice of Appeal.*

The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.

REMARKS

Claims 1-32 are now pending in this application. Claims 18-26 have been withdrawn. Claims 1, 6, 12 and 27 are independent claims.

Errors in Law-102 Rejections

Claims 1, 5, 6, 10-17, 27, 28, 31 and 32 were rejected under 35 U.S.C. § 102(e) as being anticipated by Nicholson USPN: 6,724,308 (hereinafter: Nicholson). (Pending Office Action, Page 2). Applicant respectfully traverses these rejections.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Independent Claims 1, 6, 12 and 27 recite elements that have not been disclosed, taught or suggested by Nicholson. For example, claims 1, 6, 12 and 27 each generally recite:

> "said data storage device is a drive tray or a controller".

The Patent Office cites Nicholson as disclosing a container. (Pending Office Action, Page 2). Further, the Patent Office asserts that the container (102) of Nicholson is equivalent to the claimed data storage device of the present invention. (Pending Office Action, Page 2). Still further, the Patent Office states that the container (102) of Nicholson, like the data storage device of the present invention, is a drive tray or a controller. (Pending Office Action, Page 2). However, Applicant respectfully points out that nowhere in Nicholson is it disclosed, taught or suggested that its container (102) is either a drive tray or a

controller. Therefore, Applicant contends that the container (102) of Nicholson ***cannot*** be construed as being equivalent to the claimed data storage device of the present invention.

Nicholson discloses an antenna system (Nicholson: Column 4: Line 53 through Column 5: Line 5; reference numerals 14, 24; FIGS. 1 and 2). The antenna system (24) of Nicholson includes panels (23). (Nicholson: Column 4: Lines 61-67). The above-mentioned container (102) of Nicholson may include an attached tag, so that when the container (102) is passed through the antenna system (24) as indicated in FIG. 2 (see Arrow "A"), the tag on the container may be communicated with by the panels (23) of the antenna system (24). (Nicholson, Column 4: Line 53 through Column 5: Line 5). Nicholson ***does*** discuss "a controller" at Column 5, Lines 2-5 (See also FIG. 2; Reference Numeral 28). However, Applicant points out that the controller (28) of Nicholson is utilized for controlling the operation of the panels (23) of the antenna system (24), and is a distinct and separate entity from the container (102) of Nicholson, (which is passed through the antenna system (24)). Thus, Nicholson does not disclose, teach or suggest that its container (102) is a controller. Further, after diligent search, Applicant was unable to locate in Nicholson any reference to a drive tray. Thus, Nicholson does not disclose, teach or suggest that its container (102) is a drive tray. As mentioned above, the Patent Office cites the container of Nicholson as being equivalent to the data storage device of the present invention. However, the data storage device, as claimed in the present invention is a drive tray or a controller. As discussed above, Nicholson does not disclose, teach or suggest that its container is a drive tray or a controller. Therefore, the container disclosed in Nicholson cannot be construed as being equivalent to the claimed data storage device of the present invention.

Therefore, based on the above rationale, it is contended that Nicholson does not teach the above-referenced elements of Claims 1, 6, 12 and 27. Under *Lindemann*, a prima facie case of anticipation has not been established for Claims 1, 6, 12 and 27. Thus, independent claims 1, 6, 12 and 27 should be allowed. Dependent claim 5 (which depends on independent Claim 1),

dependent claims 10 and 11 (which depend on independent Claim 6), dependent claims 13-17 (which depend on independent Claim 12) and dependent claims 28, 31 and 32 (which depend on independent Claim 27) should also be allowed.

Errors in Law-103 Rejections

Claims 2-4, 7-9 and 29-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nicholson in view of Stevens, III, United States Patent Number: 6,747,560 (hereinafter: Stevens). Applicant respectfully traverses these rejections.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added) (MPEP § 2143). "If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious." (emphasis added) *In re Fine*, 837 F. 2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988). Applicant respectfully submits that independent Claims 1, 6, 12 and 27 include elements that do not appear to have been disclosed by any of the references cited by the Patent Office, either alone or in combination.

It is contended that Independent Claims 1, 6, 12 and 27 are non-anticipatory and non-obvious based on the rationale above, therefore Independent Claims 1, 6, 12 and 27 should be allowed. Thus, Dependent Claims 2-4 (which depend on Independent Claim 1), Dependent Claims 7-9 (which depend on Independent Claim 6) and Dependent Claims 29 and 30 (which depend on Independent Claim 27) should also be allowed.

In light of the foregoing, Applicant respectfully submits that a *prima facie* case of obviousness is not shown, therefore, removal of the pending rejection under 35 U.S.C. §103(a) to claims 2-4, 7-9 and 29-30 is requested and allowance is earnestly solicited.

CONCLUSION

In light of the forgoing, reconsideration and allowance of the pending claims is earnestly solicited.

Respectfully submitted on behalf of
LSI Logic,

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DATED: December 14, 2006

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